UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/966,700	09/28/2001	Steven G. Smith	BELL-0138/01189	6438

38952	7590	08/23/2005

WOODCOCK WASHBURN LLP
ONE LIBERTY PLACE - 46TH FLOOR
PHILADELPHIA, PA 19103

EXAMINER
YANG, LINA

ART UNIT	PAPER NUMBER
2665	

DATE MAILED: 08/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO 90C (Rev 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/966,700	SMITH ET AL.
	Examiner	Art Unit	
	Lina Yang	2665	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>28 September 2001</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-10</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-10</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>9/28/2001</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly
claiming the subject matter which the applicant regards as his invention.

1.   Claims 7 and 9 are rejected under 35 U.S.C. 112, second paragraph.

Claims 7 and 9 provides for the use of method in claim 1 (8), but, since the

claims do not set forth any steps involved in the method/process, it is unclear what

method/process applicant is intending to encompass. A claim is indefinite where it

merely recites a use without any active, positive steps delimiting how this use is actually

practiced.

Claims 7 and 9 are rejected under 35 U.S.C. 101 because the claimed recitation

of a use, without setting forth any steps involved in the process, results in an improper

definition of a process, i.e., results in a claim which is not a proper process claim under

35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and

Clinical Products, Ltd. v. *Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set
forth in section 102 of this title, if the differences between the subject matter sought to be patented
and the prior art are such that the subject matter as a whole would have been obvious at the time the
invention was made to a person having ordinary skill in the art to which said subject matter pertains.
Patentability shall not be negatived by the manner in which the invention was made.

2.   Claims 1-3, 6-7 and 10 are rejected under 35 U.S.C. 103(a) as being

unpatentable over by McDowell et al (U. S. Patent No. 6,839,554 B2) in view of Yukie et

al. (U. S. Patent Application No. 20030031150 A1).

Regarding claim 1, McDowell teaches a method of sending data from a first

computing device (laptop computer 48 in fig. 1) to at least one of a plurality of second

computing devices (instant messaging subscriber 30-34 in fig. 1) over a wireless digital

packet-switched network (wireless packet data network 44 in fig. 1), the method

comprising:

initiating a first application ("sign on" to Instant message service 36, 38 and 40 in

fig. 1 col. 1 lines 26-34) on a first computing device including a wireless modem (laptop

computer 48 with wireless modem in fig. 1, abstract);

initiating a second application ("send instant message" col. 1 lines 26-34) on the

first computing device, the second application enabling data to be sent from the first

computing device to the at least one of the plurality of second computing devices (any

alive instant messaging subscriber 30-34 in fig. 1) over a wireless digital packet-

switched network (wireless packet data network 44 in fig. 1);

generating data to be sent from the first computing device to the at least one of

the plurality of second computing devices, wherein data is generatable from the first

application and the second application and is transmitted by way of a wireless modem

(col. 1 lines 26-34).

initiating a request to a modem controller for access to the wireless modem; and

transmitting the generated data from the first computing device to the second computing

device (inherent, when the modem is used to transferring data).

McDowell differs from the claimed invention in that McDowell does not

specifically specifies that the wireless modem contained the laptop computer 48 in fig. 1

is a wireless digital packet-switched modem. However, the laptop computer 48 is

wirelessly accessing a wireless packet data network 44 through the wireless modem, as

shown in fig. 1. It is within the level of one skilled in the art to see that a wireless digital

packet-switched modem should be used to access the wireless packet data network.

For example, Yukie teaches a dual network modem can be used to access wireless

packet switched networks ([0005]). Therefore, it would have been obvious for one of

ordinary skill in the art at the time when the invention was made to use the wireless

digital packet-switched modem, as taught by Yukie in the assembly of McDowell in

order to provide faster data transmission.

Regarding claim 2, McDowell further teaches that the first application (sign on)

can access a plurality of remote data systems (instant message service 36, 38 and 40

in fig. 1).

Regarding claim 3, McDowell further teaches that the generated data comprises

a message ("instant message" col. 1 lines31-34).

Regarding claim 6, McDowell further teaches that the method further comprising establishing an interactive connection between the first computing device and the second computing device (instant message is interactive) .

Regarding claim 7, McDowell differs from the claimed invention in that McDowell does not specifically specifies a computer-readable medium containing computer-executable instructions for performing the method. However, it is with the level of one skilled in the art to implement the method as software or computer program instructions. It would have been obvious to one of ordinary skill at the time of the invention to store the computer program instructions on a computer readable medium so they are executable on a processor.

Regarding claim 10, McDowell teaches a system for sending data over a wireless digital packet-switched network (wireless packet data network 44 in fig. 1) from a first computing device (laptop computer 48 in fig. 1) to at least one of a plurality of second computing devices (instant messaging subscriber 30-34 in fig. 1), the system comprising: a first computing device (laptop computer 48 in fig. 1) including a wireless modem; and a wireless digital packet-switched network (wireless packet data network 44 in fig. 1); and a computer system comprising at least one of a plurality of second computing devices (computer system contains: instant messaging subscriber 30, 32 and 34 and instant messaging service 36, 38 and 40 in fig. 1).

McDowell differs from the claimed invention in that McDowell does not specifically specifies that the wireless modem contained the laptop computer 48 in fig. 1 is a wireless digital packet-switched modem and a modem controller that controls access to the wireless digital packet-switched network. However, the laptop computer 48 is wirelessly accessing a wireless packet data network 44 through the wireless modem, as shown in fig. 1. It is within the level of one skilled in the art to see that a wireless digital packet-switched modem should be used to access the wireless packet data network. For example, Yukie teaches a dual network modem can be used to access wireless packet switched networks ([0005]) and a modem controller that controls access to the wireless digital packet-switched network (330 in fig. 3 and 430 in fig. 4). Therefore, it would have been obvious for one of ordinary skill in the art at the time when the invention was made to use the wireless digital packet-switched modem, and a modem controller that controls access to the wireless digital packet-switched network as taught by Yukie in the assembly of McDowell in order to provide faster data transmission.

3.   Claims 4-5 and 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over by McDowell et al (U. S. Patent No. 6,839,554 B2) in view of Brown (U. S. Patent Application No. 20030023684 A1).

Regarding claim 4, McDowell differs from the claimed invention in that McDowell does not specifically teaches that the message is addressed to a user represented by a user identifier. However, it is well know in the art that a message is addressed to a user

identifier. For example, Brown teaches that a sending user may provide an user

identifier for an intended receiving user ([0049]). Therefore, it would have been obvious

for one of ordinary skill in the art at the time when the invention was made to include

specifying the message is addressed to a user represented by a user identifier, as

taught by Brown in the assembly of McDowell in order to deliver the message.

Regarding claim 5, McDowell differs from the claimed invention in that McDowell

does not specifically teaches that the user identifier comprises one of a group of allowed

recipients. However, Brown teaches that "user" can refer to individual, group,

organization et al ([0048]). Then, a user identifier can be an identifier for an individual or

a group. Therefore, it would have been obvious for one of ordinary skill in the art at the

time when the invention was made to include the user identifier comprises one of a

group of allowed recipients, as taught by Brown in the assembly of McDowell in order to

deliver the message correctly and efficiently.

Regarding claim 8, McDowell teaches a method of receiving data sent from a first

computing device (laptop computer 48 with a wireless modem in fig. 1) to at least one of

a plurality of second computing devices (instant messaging subscriber 30-34 in fig. 1),

over a wireless digital packet-switched network (wireless packet data network 44 in fig.

1), the method comprising: receiving data ((instant messaging service 36, 38 and 40 in

fig. 1 receiving the data) from a messaging application running on a computing device

(instant message application running on 48 in fig. 1)over a wireless digital packet-

switched network (wireless packet data network 44 in fig. 1), while maintaining contact

with a remote systems (instant messaging service 36, 38 and 40 in fig. 1) accessing

application running on the computing device.

McDowell differs from the claimed invention in that McDowell does not

specifically teach determining an intended recipient of the data; forwarding the data to

the intended recipient. However, Brown teaches that the message server ("instant

message service" node in McDowell) receives the message, determines an intended

recipient of the data; forwards the data to the intended recipient ([0069]). Therefore, it

would have been obvious for one of ordinary skill in the art at the time when the

invention was made to include determining an intended recipient of the data; forwarding

the data to the intended recipient, as taught by Brown in the assembly of McDowell in

order to deliver the message.

Regarding claim 9, McDowell differs from the claimed invention in that McDowell

does not specifically specifies a computer-readable medium containing computer-

executable instructions for performing the method. However, it is with the level of one

skilled in the art to implement the method as software or computer program instructions.

It would have been obvious to one of ordinary skill at the time of the invention to store

the computer program instructions on a computer readable medium so they are
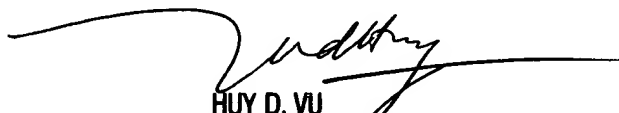
executable on a processor.

Conclusion

4.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lina Yang whose telephone number is (571)272-3151. The examiner can normally be reached on 7:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy Vu can be reached on (571)272-3155. The fax phone number for the organization where this application or proceeding is assigned is 517-273-8300..

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LY

HUY D. VU
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600